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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,389	01/08/2001	Frank Addante	16113-1347001/GP-1700-09	6110
26192 7590 04/10/2009 FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER DURAN, ARTHUR D	
			ART UNIT 3622	PAPER NUMBER
			NOTIFICATION DATE 04/10/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/757,389	Applicant(s) ADDANTE, FRANK	
	Examiner Arthur Duran	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-24 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 13-24 and 26 have been examined.

Response to Amendment

2. The Amendment filed on 2/19/09 is insufficient to overcome the prior rejection.

Election/Restrictions

3. Claim 1-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Election was made of Group II or claims 13-24 in the reply filed on 7/31/06.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles (5,933,811) in view of Hu (6,173,322).

Claim 13: Angles discloses:

a creative selection server coupled to a network; (Fig. 2, item 18; Fig. 4, item 18;)

a content server, coupled to the network separately from the creative selection server (Fig. 2, item 14; Fig. 4, item 14), that issues at least one redirect command to a user computer in response to receiving a user request for non-advertising content ,

wherein the redirect command is configured to direct the user computer to a direct connect server (Fig. 4; Fig. 3, items 302, 304, 306; col 15: 1-12); and

the direct connect server being connected to the network; and the creative selection server and the content server, being separately connected, wherein the direct connect server (Fig. 2):

receives creative selection criteria from the user computer (Fig. 3, items 304, 306, 308, 310; Fig. 4); and

responsive to the user request to receive non-advertising content and the at least one redirect command from the content server (Fig. 4, Fig. 3):

generates a request for a creative message as a function of the creative selection criteria (Fig. 4; Fig. 3);

transmits the request for the creative message to the creative selection server (Fig. 4; Fig. 3);

receives an identification of one or more creatives from the creative selection server (Fig. 3, item 310); and

sends the identification of the one or more creatives to the user computer (Fig. 3, item 310; Fig. 4, step F; Fig. 1; Fig. 2).

Examiner notes that Applicant's claim 13 has four separate computers (user computer, content server, direct connect server, creative selection server). Also, the claim 13 relation between the four computers can be described as follows. A user computer requests non-ad content from a content server. The content server gives a redirect command to the user computer that requests ad content from a direct connect

server. The direct connect server then requests the ad content from a creative selection server. And, the prior art combination renders obvious these features.

In Figure 2, Angles discloses that the user, advertiser/creative selection server, and content provider can all communicate with each other (Figure 2). Hence, Angles in Figure 2 already discloses three of the four computers. Angles discloses the user computer, the content server, and the advertisement computer. Angles discloses that the user requests content from the content server (Figures 3, 4). The content server then returns the content to the user and also a redirect command that redirects the user to the advertisement provider in order to receive the advertisement content (Fig. 3, 4; Fig. 3, items 304, 306; 310; Fig. 4, item 32; col 15: 1-12). Notice in Angles that the user receives the content from the content provider server. And, the user receives the advertisement content directly from the advertisement provider (col 13:20-31). And, the advertisement provided to the user is based user information such as user preference information and also that the ad can be relevant to the content provided (Figs. 3, 4).

Hence, Angles discloses all the Applicant's features except for a separate direct connect server and creative selection server. Angles advertisement provider computer performs the functions of both the Applicant's direct connect server and creative selection server. Angles does not explicitly disclose that the advertisement provider can utilize both a direct connect server and a creative selection server in order to perform the functions of the advertisement provider computer. Angles also does not disclose that the direct connect server and creative selection server are separately connected to the network.

However, Angles discloses an advertisement provider service with a multitude of databases and servers (Fig. 4, item 18; Fig. 2, item 18). And, Angles discloses a variety of server configurations at the advertisement provider for handling ad request, ad selection, and ad providing (Fig. 4, item 18; col 6: 4-12; col 13: 35-46; col 14:59-67). Hence, it would be obvious to one skilled in the art that Angles can use more than one server to perform the advertisement provider functions. One would be motivated to do this because the features are merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Additionally, as an example of this, Hu discloses that when a content request is made that a Network Request Manager can be directly connected to the Internet and provide information to one of many Content Servers which are also directly connected to the Internet. And, that the Content Server can then provide the content to the user (Fig. 1; Fig. 9b; Abstract). Hence, Hu's Network Request Manager functions as the Applicant's claimed direct connect server and Hu's content server functions as the Applicant's claimed creative selection server.

Hence, it is obvious that the advertisement content provided by Angles' advertisement provider server(s) is a type of content that can be provided by Hu's general content providing server(s) configurations. Or, it is obvious that the content provided by Hu can be a variety of content from non-ad content to ad content to a wide variety of content. Hence, it is obvious that Angles advertisement provider functions

Art Unit: 3622

can be performed by more than one separately connected servers. One would be motivated to do this in order to more efficiently provide the content (as Hu discloses).

Hence, the combination of the prior art renders obvious the Applicant's claims.

Claim 14: Angles discloses the request for creative message of claim 13 further defined as a function of a stored profile (col 13:20-31).

Claims 15, 16, 18:

The prior art discloses the above. Angles does not explicitly disclose using IP address for targeting.

However, Angles discloses utilizing the IP address and the content provider as relevant communications information and utilizing the Internet Service provider of the user as relevant criteria for selection/targeting purposes (col 7, lines 10-26; col 9, lines 20-30; col 9, lines 35-45; col 10, lines 20-34 ; col 14, lines 15-26; col 16, lines 25-38; col 17, lines 3-10).

Angles further discloses that domain name of the content server can be a criteria (col 11, lines 17-26).

Also, it is old and well known that different Internet Service Providers are going to utilize different domain names.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that IP information or domain information can be utilized as a criteria in Angles's targeting based on a range of criteria. One would have been motivated to better use available information for targeting.

Claim 17: Angles discloses the request for creative message of claim 13 further defined as a function of whether or not the user computer has previously connected to the content server (Fig. 5; col 13:20-31). Note that the user registers and that a profile is kept. Hence, new users are known.).

Claim 19: Angles discloses the request for creative message of claim 13 further defined as a function of a search term entered by the user computer (2:20-30; 6:5-15).

Claims 20, 22: Angles further discloses that the content server that placed the content can be a criteria for the advertisement that is provided (col 13:20-31).

Claim 21: Angles discloses the request for creative message of claim 13 further defined as a function of whether or not the user computer has previously connected to the direct connect server (Fig. 5; col 13:20-31). Note that the user registers and that a profile is kept. Hence, new users are known.

Claim 23: Angles discloses the request for creative message of claim 13 further defined as a function of a meta tag on the content server (col 13:20-31).

Claim 24: Angles discloses the direct connect server of claim 13 further comprising a lookup table for storing category codes for use in generating a request for creative message (col 15: 30-42).

Claim 26: Please see the rejection of claim 13 above and particularly the citations to the Hu reference.

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are not found persuasive.

On page 5 of the Applicant's Remarks dated 2/19/09, Applicant states:

"neither Angles, Hu, nor any proper combination of the two describes or suggests at least a "direct connect server connected to the network separately from the creative selection server and the content server. . . Thus, the direct connect server interacts with the user computer and with the creative selection server, while the user computer interacts with the content server and the direct connect server such that the claim recites four different entities."

On page 7, Applicant states, "Hu discusses only a request for content and a response thereto, and does not disclose a first request for a first type of content (i.e. non-advertising content) and a second request for a second type of content (i.e. creative content) based on the first request."

However, Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

And, it is the 103 combination of Angles and Hu that renders the Applicant's features obvious.

Examiner notes that Applicant's claim 13 has four separate computers (user computer, content server, direct connect server, creative selection server). Also, the claim 13 relation between the four computers can be described as follows. A user

computer requests non-ad content from a content server. The content server gives a redirect command to the user computer that requests ad content from a direct connect server. The direct connect server then requests the ad content from a creative selection server. And, the prior art combination renders obvious these features.

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that the direct connect server and creative selection server are separately connected to the network.

However, Angles discloses an advertisement provider service with a multitude of databases and servers (Fig. 4, item 18; Fig. 2, item 18). And, Angles discloses a variety of server configurations at the advertisement provider for handling ad request, ad selection, and ad providing (Fig. 4, item 18; col 6: 4-12; col 13: 35-46; col 14:59-67). Hence, it would be obvious to one skilled in the art that Angles can use more than one server to perform the advertisement provider functions. One would be motivated to do this because the features are merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Additionally, as an example of this, Hu discloses that when a content request is made that a Network Request Manager can be directly connected to the Internet and provide information to one of many Content Servers which are also directly connected to the Internet. And, that the Content Server can then provide the content to the user (Fig. 1; Fig. 9b; Abstract). Hence, Hu's Network Request Manager functions as the Applicant's claimed direct connect server and Hu's content server functions as the Applicant's claimed creative selection server.

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provided by Hu can be a variety of content from non-ad content to ad content to a wide variety of content. Hence, it is obvious that Angles advertisement provider functions can be performed by more than one separately connected servers. One would be motivated to do this in order to more efficiently provide the content (as Hu discloses).

Hence, the combination of the prior art renders obvious the Applicant's claims.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) McCanne 20050010653 at Abstract; Primak 20020010783 at (claim 13); Joffe (6185619) at (Det Paragraph 58); and Lewis 6553376 at (Det 28) disclose relevant features to distributing/spreading server loads across content servers when content is requested. These also disclose relevant features to redirecting and direct connect servers.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran
Primary Examiner
Art Unit 3622

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4/7/2009